

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

NEUROGRAFIX, a California corporation;
NEUROGRAPHY INSTITUTE MEDICAL
ASSOCIATES, INC., a California
corporation; and IMAGE-BASED
SURGICENTER CORPORATION, a
California corporation,

Plaintiffs,

vs.

BRAINLAB, INC., et al.,

Defendants.

Civil Action No. 12-cv-6075

Judge John W. Darrah

Magistrate Judge Jeffrey Cole

Jury Trial Demanded

**PLAINTIFFS NEUROGRAFIX, NEUROGRAPHY INSTITUTE MEDICAL
ASSOCIATES, INC., AND IMAGE-BASED SURGICENTER CORPORATION'S
ANSWER TO DEFENDANTS' COUNTERCLAIMS AND DEMAND FOR JURY TRIAL**

Plaintiffs NeuroGrafix, Neurography Institute Medical Associates, Inc. ("NIMA"), and Image-Based Surgicenter Corporation ("IBSC") (collectively, "NeuroGrafix"), by and through their undersigned counsel, answers the Counterclaims of Defendants Brainlab AG and Brainlab, Inc. (collectively, "Brainlab") by corresponding paragraph number as follows:

Jurisdiction and Venue

32. Brainlab incorporates herein and realleges its answers to paragraphs 1-31.

ANSWER: NeuroGrafix incorporates the allegations in its Complaint as if fully set forth herein.

33. Brainlab asserts counterclaims under the Federal Declaratory Judgment Act, 28 U.S.C. section 2201, seeking declaratory judgments under the patent laws of the United States, United States Code Title 35, that the claims of the '360 patent asserted by the plaintiffs are invalid and not infringed.

ANSWER: NeuroGrafix admits that Brainlab purports to assert counterclaims seeking declaratory judgments that the claims of the '360 patent asserted by NeuroGrafix are invalid and not infringed, but NeuroGrafix denies that Brainlab is entitled to any such relief.

34. This Court has subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. sections 1331, 1338(a), 2201, and 2202, and 35 U.S.C. section 1, et seq.

ANSWER: Admitted.

35. Plaintiffs have submitted to the personal jurisdiction of this Court at least by filing Case No. 12-cv-6075 in this Court.

ANSWER: Admitted.

36. Venue is proper as to plaintiffs in this district pursuant to 28 U.S.C. section 1391 because plaintiffs filed this action in this district.

ANSWER: Admitted.

The Parties

37. Brainlab AG is a German corporation with its principal place of business in Germany.

ANSWER: Admitted.

38. Brainlab, Inc. is a Delaware corporation with its principal place of business in Westchester, Illinois.

ANSWER: Admitted.

39. NeuroGrafix, Neurography Institute Medical Associates, Inc., and Image-Based Surgicenter Corporation purport to be California corporations with principal places of business in Santa Monica, California.

ANSWER: Admitted.

**Counterclaim 1:
Declaratory Judgment of Non-Infringement of the '360 Patent**

40. Brainlab repeats and realleges paragraphs 1-39 above as if fully set forth herein.

ANSWER: NeuroGrafix incorporates the allegations in its Complaint and its response to paragraphs 32-39 of Brainlab's Counterclaims as if fully set forth herein.

41. NeuroGrafix alleges in its Complaint that it is the owner of the '360 patent, entitled "Image Neurography and Diffusion Anisotropy Imaging," which bears an issue date of October 1, 1999.

ANSWER: Denied. NeuroGrafix alleges in its Complaint that the University of Washington is the owner by assignment of the '360 patent. Plaintiffs are the exclusive licensees of the '360 patent.

42. Plaintiffs have sued Brainlab in the present action alleging infringement of the '360 patent. Thus, an immediate, real, and justiciable controversy exists between Brainlab and plaintiffs with respect to the alleged infringement of the '360 patent.

ANSWER: Admitted.

43. Brainlab does not infringe, has not infringed, and does not and has not induced infringement or contributed to infringement of any claim of the '360 patent under any theory, including literal infringement and infringement under the doctrine of equivalents.

ANSWER: Denied.

44. Brainlab requests declaratory judgment that Brainlab does not infringe, directly or indirectly, any claim of the '360 patent.

ANSWER: NeuroGrafix admits that Brainlab purports to request a declaratory judgment that Brainlab does not infringe, directly or indirectly, any claim of the '360 patent, but NeuroGrafix denies that Brainlab is entitled to any such relief.

**Counterclaim 2:
Declaratory Judgment of Invalidity of the '360 Patent**

45. Brainlab repeats and realleges paragraphs 1-44 above as if fully set forth herein.

ANSWER: NeuroGrafix incorporates the allegations in its Complaint and its response to

paragraphs 32-44 of Brainlab's Counterclaims as if fully set forth herein

46. An immediate, real, and justiciable controversy exists between Brainlab and plaintiffs with respect to the invalidity of the '360 patent.

ANSWER: Admitted.

47. Claims of the '360 patent are invalid for failure to comply with one or more provisions of Title 35, United States Code, including but not limited to 35 U.S.C. §§ 101, 102, 103 and/or 112, paragraphs 1 and 2.

ANSWER: Denied.

PRAYER FOR RELIEF

WHEREFORE, NeuroGrafix prays for the following relief with regard to Brainlab's

Counterclaims:

1. A dismissal with prejudice of Brainlab's Counterclaims;
2. An adjudication that Brainlab is not entitled to any relief on its Counterclaims, including, without limitation, any fine or damages; and
3. Costs and such further relief to which NeuroGrafix is entitled, and which the Court deems just and equitable.

JURY TRIAL DEMANDED

Plaintiffs hereby demand a trial by jury of all issues so triable.

Respectfully submitted,

Dated: December 10, 2012

s/ Kirsten L. Thomson
Kirsten L. Thomson (ID No. 6293943)
(thomson@mbhb.com)
McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606
Tel.: (312) 913-0001
Fax: (312) 913-0002

Marc A. Fenster

(mfenster@raklaw.com)

Andrew D. Weiss

(aweiss@raklaw.com)

Fredricka Ung

(fung@raklaw.com)

Russ August & Kabat

12424 Wilshire Boulevard, 12th Floor

Los Angeles, California 90025

Tel. 310.826.7474

Fax 310.826.6991

Attorneys for Plaintiffs,

NEUROGRAFIX, NEUROGRAPHY

INSTITUTE MEDICAL ASSOCIATES, INC.,

AND IMAGE-BASED SURGICENTER

CORPORATION

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing document PLAINTIFFS NEUROGRAFIX, NEUROGRAPHY INSTITUTE MEDICAL ASSOCIATES, INC., AND IMAGE-BASED SURGICENTER CORPORATION'S ANSWER TO DEFENDANTS' COUNTERCLAIMS AND DEMAND FOR JURY TRIAL was served on December 10, 2012 as follows:

Via Filing Via this Court's CM-ECF System, which caused a copy to be served on all registered users by E-mail:

Kyle B. Fleming
Todd R. Tucker
Renner, Otto, Boisselle & Sklar, LLP
1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
Telephone: (216) 621-1113
Facsimile: (216) 621-6165
Email: kfleming@rennerotto.com
Email: ttucker@rennerotto.com

John L. Ambrogi (No. 6203626)
McCracken & Frank LLC
311 S. Wacker Drive, Suite 2500
Chicago, Illinois 60606
Tel: (312) 263-4700
Facsimile: (312) 263-3990
Email: jambrogi@mccrackenfrank.com

Counsel for Defendants:
Brainlab AG;
Brainlab, Inc.

/s/Kirsten L. Thomson